



Atty. Dkt. No. 029311-061

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bosch et al.

Title: LIQUID DROPLET AEROSOLS OF NANOPARTICULATE DRUG

Appl. No.: 09/597,738

Filing Date: 06/19/2000

Examiner: R. Bawa

Art Unit: 1619

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Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

This Paper is filed in response to the Office Action requiring restriction of the claims, mailed on October 5, 2001. While a shortened statutory period for response has expired, filed herewith is a Petition to extend the period of response to **December 5, 2001**.

REMARKS

The Examiner restricted the claims of the application into two groups as follows:

Group I: claims 11-38, 47-64, 79-81, and 84-101, drawn to an aerosol composition; and

Group II: claims 40-45, 65-78, 82-83, and 102-117, drawn to a method.

While the Examiner included claims 11-38 and 47-50 in the restriction requirement, claims 11-38, 40-45, and 47-50 were cancelled in the Transmittal Letter of the application, filed on June 19, 2000. This was also noted at page 5 of the Preliminary Amendment, filed on July 5, 2000, where it is stated that "[c]laims 1-50 [of the application] have been cancelled . . . and claims 51-79 have been added to the application." Finally, at page 6 of the Second Preliminary Amendment, filed on November 17, 2000, it is stated that "[f]ollowing entry of this amendment, claims 51-117 will be pending."

Applicants elect for prosecution Group I, claims 51-64, 79-81, and 84-101, drawn to an aerosol composition, with traverse (as noted above, claims 11-38 and 47-50 have been previously cancelled).

Applicants traverse the restriction on the grounds that the Examiner has failed to properly establish the need for a restriction requirement. The criteria for a proper restriction requirement, according to MPEP § 803, is that the Examiner must establish that the inventions are independent or distinct as claimed and that there is a serious burden on the Examiner to examine the entire application. In the present case, the Examiner has failed to establish that the search and examination of the two groups of claims, which are related as compositions and methods of making such compositions, is unduly burdensome.

Accordingly, it is respectfully requested that the restriction requirement of the claims be withdrawn.

If there are any fees due in connection with the filing of this Amendment, please charge the fees to our Deposit Account No. 19-0741. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: Nov. 14 2000



Michele M. Simkin
Reg. No. 34,717

Foley & Lardner
Washington Harbour
3000 K Street, N.W.
Washington, D.C. 20007
Phone: (202) 672-5538
Fax: (202) 672-5399